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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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MICHAEL J. HELLER

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1976

34263

7590

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O'Melveny & Myers LLP
IP&T Calendar Department LA-13-A7
400 South Hope Street
Los Angeles, CA 90071-2899

EXAMINER

FORMAN, BETTY J

ART UNIT

PAPER NUMBER

1634

MAIL DATE

DELIVERY MODE

04/01/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/358,788	Applicant(s) HELLER ET AL.	
	Examiner BJ Forman	Art Unit 1634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 49,54,55,57 and 58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 49,54,55,57 and 58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/02, 1/04</u> . | 6) <input type="checkbox"/> Other: _____ |

FINAL ACTION

Status of the Claims

1. This action is in response to papers filed 9 August 2001 in which the title was changed, the specification was amended to define the nucleotides by SEQ ID NO., claims 49 and 58 were amended and claims 50-53, 56, 59-78 were canceled. The amendments have been thoroughly reviewed and entered.

The previous objections and rejections in the Office Action dated 6 February 2001 withdrawn in view of the amendments.

New grounds for rejection, necessitated by the amendments, are discussed.

The examiner and Art Unit for this application have changed. Please address future correspondence of Examiner BJ Forman, Art Unit: 1634.

Claims 49, 54-55, 57-58 are under prosecution.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 54-55 and 58 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims are drawn to the method of Claim

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49 wherein the anchor sequence is "about 10 to about 100 bases" (Claim 54); "about 20 to about 40 bases" (Claim 55); and "about 6 to about 100 bases" (Claim 58). Applicant points to page 31, line 12 for support of the claimed ranges. The cited passage defines the oligonucleotides in the range of 6 to 100 bases. The cited passage does not teach the instantly claimed ranges of 10 to 100 or 6 to 100 or "about 20" to "about 100".

Therefore, the specification, as originally filed, does not support the instantly claimed ranges.

"Thus, the written description requirement prevents an applicant from claiming subject matter that was not adequately described in the specification as filed. New or amended claims which introduce elements or limitations which are not supported by the as-filed disclosure violate the written description requirement. See, e.g., *In re Lukach*, 442 F.2d 967, 169 USPQ 795 (CCPA 1971) (subgenus range was not supported by generic disclosure and specific example within the subgenus range); *In re Smith*, 458 F.2d 1389, 1395, 173 USPQ 679, 683 (CCPA 1972) (a subgenus is not necessarily described by a genus encompassing it and a species upon which it reads)." (MPEP § 2163).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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5. Claims 49 and 58 are rejected under 35 U.S.C. 102(b) as being anticipated by MacConnell (U.S. Patent No. 4,787,963, issued 29 November 1988).

Regarding Claim 49, MacConnell discloses a method for analyzing a sample sequence comprising contacting the sample with a filter-immobilized oligonucleotide and a second probe which hybridizes to the target, subjecting the complex to an electric field to remove unbound sequences and determining probe bound (Column 2, line 59-Column 3, line 21; Column 4, line 65-Column 5, line 20; and Claims 1-16).

Regarding Claim 57, MacConnell discloses the method further comprising subjecting the probe to a field to concentrate the probe near the anchor (Column 4, line -Column 5, line 20).

6. Claims 49, 54-55, 57-58 are rejected under 35 U.S.C. 102(e) as being anticipated by Okano et al (U.S. Patent No. 5,434,049, filed 24 February 1993).

Regarding Claim 49, Okano discloses a method for analyzing a sample sequence comprising contacting the sample with a filter-immobilized oligonucleotide and a second probe which hybridizes to the target, subjecting the complex to an electric field to remove unbound sequences and determining probe bound (Example 3, Column 9-10).

Regarding Claims 54-55 and 58, Okano discloses the method wherein the anchor probes are 20-40 bases (Example 3).

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Regarding Claim 57, Okano discloses the method further comprising subjecting the probe to a field to concentrate the probe near the anchor (Example 3).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 54-55 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacConnell (U.S. Patent No. 4,787,963, issued 29 November 1988) in view of Okano et al (U.S. Patent No. 5,434,049, filed 24 February 1993).

Regarding Claim 49, 54-55 and 58, MacConnell discloses a method for analyzing a sample sequence comprising contacting the sample with a filter-immobilized oligonucleotide and a second probe which hybridizes to the target, subjecting the complex to an electric field to remove unbound sequences and determining probe bound (Abstract). MacConnell is silent regarding the length of the anchor sequences. However, Okano teaches a similar method wherein the probes fall within the claimed ranges (Example 3). It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to apply the well known probe length as taught by Okano to the probes of MacConnell. One of ordinary skill in the art would have been

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motivated to do so with a reasonable expectation of success based on the well know practice of using such probes as exemplified by Okano.

Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BJ Forman whose telephone number is (571) 272-0741. The examiner can normally be reached on 6:00 TO 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla can be reached on (571) 272-0735. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BJ Forman
Primary Examiner
Art Unit 1634

/BJ Forman/
Primary Examiner, Art Unit 1634